

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JEFFERY MOORE

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Appeal No. 96-2852  
Application 08/055,573<sup>1</sup>

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ON BRIEF

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Before CALVERT, STAAB, and McQUADE, Administrative Patent Judges.  
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1 and 2, all of the claims pending in the application.

The invention relates "generally to marking devices used in construction for marking a straight line, and more particularly to a chalk box containing a line covered with powdered chalk" (specification, page 1). Claim 1 is illustrative and reads as follows:

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<sup>1</sup> Application for patent filed May 3, 1993.

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1. A chalk box comprising:
  - a) a case having a hollow cavity, said case including a generally teardrop-shaped main body section having a longitudinal axis and an arched neck joining the main body [section]<sup>2</sup> along its longitudinal axis, wherein the arched neck extends forwardly from said main body section and curves to one side thereof;
  - b) a line aperture formed at a forward portion of the neck communicating with the interior of the case;
  - c) a reel rotatably mounted within main body section of the case; and
  - d) a line wound on the reel and extending through the aperture in the case, said line exiting the case at an angle relative to the longitudinal axis of the case.

The references relied upon by the examiner as evidence of obviousness are:

Vernon	660,672	Oct. 30, 1900
Lyle	2,347,273	Apr. 25, 1944
Baumgart	2,673,398	Mar. 30, 1954
Millen	5,042,159	Aug. 27, 1991

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<sup>2</sup> The term "the main body" in clause a of claim 1 lacks a proper antecedent basis. It would appear that the word --section-- should be inserted into claim 1 as indicated above to correct this informality.

The claims on appeal stand rejected under 35 U.S.C. § 103 as follows:

a) claim 1 as being unpatentable over Millen in view of Vernon and Lyle; and

b) claim 2 as being unpatentable over Millen in view of Vernon and Lyle, and further in view of Baumgart.

Claim 1 recites a chalk box comprising, inter alia, a case including a generally teardrop-shaped main body section having a longitudinal axis and "an arched neck joining the main body [section] along its longitudinal axis, wherein the arched neck extends forwardly from the main body section and curves to one side thereof." One of the primary arguments advanced in this appeal by the appellant (see pages 4 through 13 in the brief, Paper No. 16) is that Millen, Vernon and Lyle do not disclose and would not have suggested a chalk box having such a neck. In our opinion, this argument is well founded.

Millen discloses

a chalk line retraction device 10 comprised of a hollow casing indicated generally at 12 in which a chalk line aperture 14 is formed. A chalk line winding drum or reel 16 is mounted for rotation within the casing 12. A flexible chalk line 18 has opposite ends 20 and 22. The end 20 is secured to the hub of the drum 16 by frictional engagement in a V-shaped crevice 24 therein, as depicted in FIG. 2. The other end 22 of the chalk line 18 emanates from the casing 12 through the chalk line aperture 14 [column 3, lines 24 through 33].

Millen's casing 12 can be said to include a main body section (which encloses the drum 16) and a neck (which includes the chalk line aperture 14) extending forwardly from the main body section (see Figures 1 and 3). This neck, however, is not arched and does not curve to one side of the main body section as required by claim 1.

Vernon discloses a chalk line holder having a line opening 12 consisting of a straight tubular structure extending at an angle from the main body section of the holder as shown in Figure 1.

Lyle discloses a measuring tape device having a tape opening defined by an L-shaped extension 7 extending from the main body section of the device.

In explaining the rejection of claim 1, the examiner states that

Millen discloses substantially similar structure, except for the neck dispensing at an angle. Dispensing at an angle is disclosed by Vernon and Lyle. It would have been obvious to a mechanic with ordinary skill in the art to angle the neck of Millen to dispense at an angle. The motivation is provided by the secondary references. It is noted that no patentable moment is derived from the specified shape of an article in an utility application (In re Dailey et al 149 USPQ 47) [answer, Paper No. 17, page 2].

It is not apparent, however, nor has the examiner explained, how or why Vernon's disclosure of a chalk line holder having a

line opening consisting of a straight tubular structure 12 and/or Lyle's disclosure of a measuring tape having a tape opening defined by L-shaped extension 7 would have suggested shaping the neck of Millen's casing so as to meet the above noted limitations in claim 1. The examiner's apparent attempt to overcome these deficiencies in the prior art by citing In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) for the proposition that no patentable moment is derived from the specified shape of an article in an utility application is unsound. In Dailey, the court stated that "[a]ppellants have presented no argument which convinces us that the particular configuration of their container is significant or is anything more than one of numerous configurations a person of ordinary skill in the art would find obvious" (357 F.2d at 672-73, 149 USPQ at 50). In contrast, the appellant's specification (see page 2) establishes that an arched neck as recited in claim 1 makes it easy to hold the chalk line against the surface to be marked without the need to reel out an excess amount of line or to wrap a portion of the line around user's finger, thereby increasing the user's control of the chalk box as compared to the traditional design. Thus, the shape of the neck recited in claim 1 is significant in that it solves a stated problem. Under these circumstances and given the

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foregoing deficiencies in the examiner's prior art evidence, the shape of the neck recited in claim 1 cannot be baldly dismissed as an obvious matter of design choice. Compare In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

In light of the foregoing, we shall not sustain the standing 35 U.S.C. § 103 rejection of claim 1 as being unpatentable over Millen in view of Vernon and Lyle.

Nor shall we sustain the standing 35 U.S.C. § 103 rejection of claim 2, which depends from claim 1, as being unpatentable over Millen in view of Vernon and Lyle, and further in view of Baumgart. In short, Baumgart does not cure the above noted shortcomings of the basic Millen-Vernon-Lyle combination with respect to the subject matter recited in parent claim 1.

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The decision of the examiner is reversed.

REVERSED

IAN A. CALVERT	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
JOHN P. McQUADE	)	
Administrative Patent Judge	)	

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APPLICATION NO. 08/055,573

APJ McQUADE

APJ CALVERT

APJ STAAB

DECISION: REVERSED

Typed By: Jenine Gillis

**DRAFT TYPED:** 18 Jun 98

**FINAL TYPED:**